



**UNITED STATES DEPARTMENT OF COMMERCE
Patent and Trademark Office**

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SERIAL NUMBER	FILING DATE	FIRST NAMED APPLICANT	ATTORNEY DOCKET NO.
08/265,392	12/23/96	JANNES	G 1487-14

NIXON & VANDERHYE
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8TH FLOOR
ARLINGTON VA 22201-4714

HM11/0617

EXAMINER	
HORLICK, K	
ART UNIT	PAPER NUMBER
1634	

DATE MAILED:

06/17/98

Please find below a communication from the EXAMINER in charge of this application.

Commissioner of Patents

RECEIVED

JAN 15 2003

TECH CENTER 1600/2900

DOCKETED

APP/MATTER # 1487-14
MAIL DATE 6-17-98
DUE DATE SEP 17, 1998
FINAL DEADLINE Dec 17, 1998
DOCKETED BY [signature]

Office Action Summary

Application No.
08/765,332

Applicant(s)
Jannes et al.

Examiner
Kenneth R. Horlick

Group Art Unit
1634

☒ Responsive to communication(s) filed on Mar 25, 1998

☐ This action is **FINAL**.

☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11; 453 O.G. 213.

A shortened statutory period for response to this action is set to expire three month(s), or thirty days, whichever is longer, from the mailing date of this communication. Failure to respond within the period for response will cause the application to become abandoned. (35 U.S.C. § 133). Extensions of time may be obtained under the provisions of 37 CFR 1.136(a).

Disposition of Claims

☒ Claim(s) 54-87 is/are pending in the application.

Of the above, claim(s) _____ is/are withdrawn from consideration.

☐ Claim(s) _____ is/are allowed.

☒ Claim(s) 54-59, 62, 73, 75, and 83-87 is/are rejected.

☒ Claim(s) 60, 61, 63-72, 74, and 76-82 is/are objected to.

☐ Claims _____ are subject to restriction or election requirement.

Application Papers

☒ See the attached Notice of Draftsperson's Patent Drawing Review, PTO-948.

☐ The drawing(s) filed on _____ is/are objected to by the Examiner.

☐ The proposed drawing correction, filed on _____ is ☐ approved ☐ disapproved.

☐ The specification is objected to by the Examiner.

☐ The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. § 119

☒ Acknowledgement is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d).

☒ All ☐ Some* ☐ None of the CERTIFIED copies of the priority documents have been

☐ received.

☐ received in Application No. (Series Code/Serial Number) _____.

☒ received in this national stage application from the International Bureau (PCT Rule 17.2(a)).

*Certified copies not received: _____

☐ Acknowledgement is made of a claim for domestic priority under 35 U.S.C. § 119(e).

Attachment(s)

☒ Notice of References Cited, PTO-892

☒ Information Disclosure Statement(s), PTO-1449, Paper No(s). 1

☐ Interview Summary, PTO-413

☒ Notice of Draftsperson's Patent Drawing Review, PTO-948

☐ Notice of Informal Patent Application, PTO-152

--- SEE OFFICE ACTION ON THE FOLLOWING PAGES ---

RECEIVED
JAN 15 2003
TECH CENTER 1600/2900

Art Unit: 1634

DETAILED ACTION

1. The restriction requirement mailed 09/05/97 is WITHDRAWN in favor of the following new restriction requirement.

2. *Election/Restrictions*

Restriction is required under 35 U.S.C. 121 and 372.

This application contains the following inventions or groups of inventions which are not so linked as to form a single general inventive concept under PCT Rule 13.1.

In accordance with 37 CFR 1.499, applicant is required, in response to this action, to elect a single invention to which the claims must be restricted.

Group I, drawn to detection methods using a set of probes to detect and distinguish among multiple organisms present in a respiratory tract sample.

Group II, drawn to detection methods using a set of probes to detect and distinguish among multiple organisms present in a cerebrospinal fluid sample.

Group III, drawn to detection methods using a set of probes to detect and distinguish among multiple organisms present in a urogenital tract sample.

Group IV, drawn to detection methods using a set of probes to detect and distinguish among multiple organisms present in a food sample.

Group V, drawn to detection methods using a set of probes to detect and distinguish among multiple organisms present in a gastrointestinal tract sample.

Art Unit: 1634

The inventions listed as Groups I-V do not relate to a single general inventive concept under PCT Rule 13.1 because, under PCT Rule 13.2, they lack the same or corresponding special technical features for the following reasons: each of the noted inventions relates to a different tissue sample type and to a particular set of probes targeting organisms which might be present in said different tissue sample type.

3. A telephone call was made to B.J. Sadoff on 08/18/97 to request an oral election to the former restriction requirement mailed 09/05/97, but did not result in an election being made.
4. Applicant is reminded that upon the cancellation of claims to a non-elected invention, the inventorship must be amended in compliance with 37 CFR 1.48(b) if one or more of the currently named inventors is no longer an inventor of at least one claim remaining in the application. Any amendment of inventorship must be accompanied by a petition under 37 CFR 1.48(b) and by the fee required under 37 CFR 1.17(I).
5. With respect to the above new restriction requirement, Applicant's election with traverse of Group I, new claims 54-87 in Paper No. 8 is acknowledged.
6. The title of the invention is not descriptive. A new title is required that is clearly indicative of the invention to which the claims are directed. A critical feature of the claimed invention is probes targeted to rRNA spacer regions.

BJS



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Washington, DC 20231

APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.
08/755,332	12/23/96	JARNES	1487-14

1842/0905

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ARLINGTON VA 22201-4714

EXAMINER
REPLICK, K

ART UNIT
1307

PAPER NUMBER

DATE MAILED: 09/05/97

Please find below and/or attached an Office communication concerning this application or proceeding.

Commissioner of Patents and Trademarks

DOCKETED

CLT/MATTER # 1487-14

MAIL DATE 9-5-97

DUE DATE October 5, 1997

FINAL DEADLINE February 5, 1998

DOCKETED BY CMB/pdc

Office Action Summary

DEC 23 2002
PATENT & TRADEMARK OFFICE

Application No.
08/765,332

Applicant(s)
Jannes et al.

Examiner
Kenneth R. Horlick

Group Art Unit
1807



☐ Responsive to communication(s) filed on _____

☐ This action is **FINAL**.

☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11; 453 O.G. 213.

A shortened statutory period for response to this action is set to expire one month(s), or thirty days, whichever is longer, from the mailing date of this communication. Failure to respond within the period for response will cause the application to become abandoned. (35 U.S.C. § 133). Extensions of time may be obtained under the provisions of 37 CFR 1.136(a).

Disposition of Claims

☒ Claim(s) 1-47 and 49-53 is/are pending in the application.

Of the above, claim(s) _____ is/are withdrawn from consideration.

☐ Claim(s) _____ is/are allowed.

☐ Claim(s) _____ is/are rejected.

☐ Claim(s) _____ is/are objected to.

☒ Claims 1-47 and 49-53 are subject to restriction or election requirement.

Application Papers

☐ See the attached Notice of Draftsperson's Patent Drawing Review, PTO-948.

☐ The drawing(s) filed on _____ is/are objected to by the Examiner.

☐ The proposed drawing correction, filed on _____ is ☐ approved ☐ disapproved.

☐ The specification is objected to by the Examiner.

☐ The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. § 119

☐ Acknowledgement is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d).

☐ All ☐ Some* ☐ None of the CERTIFIED copies of the priority documents have been
☐ received.

☐ received in Application No. (Series Code/Serial Number) _____.

☐ received in this national stage application from the International Bureau (PCT Rule 17.2(a)).

*Certified copies not received: _____

☐ Acknowledgement is made of a claim for domestic priority under 35 U.S.C. § 119(e).

Attachment(s)

☐ Notice of References Cited, PTO-892

☐ Information Disclosure Statement(s), PTO-1449, Paper No(s). _____

☐ Interview Summary, PTO-413

☐ Notice of Draftsperson's Patent Drawing Review, PTO-948

☐ Notice of Informal Patent Application, PTO-152

--- SEE OFFICE ACTION ON THE FOLLOWING PAGES ---

Art Unit:

Election/Restrictions

1. Restriction is required under 35 U.S.C. 121 and 372.

This application contains the following inventions or groups of inventions which are not so linked as to form a single general inventive concept under PCT Rule 13.1.

In accordance with 37 CFR 1.499, applicant is required, in response to this action, to elect a single invention to which the claims must be restricted.

The claims include probes and primers derived from the following species or related groups of species, and which are specific thereto:

- a. M. tuberculosis complex;
- b. Mycobacterial species in the MAIS complex;
- c. M. avium/M. paratuberculosis;
- d. M. intracellulare;
- e. M. scrofulaceum;
- f. M. kansasii;
- g. M. chelonae;
- h. M. gordonae;
- i. M. ulcerans/M. marinum;
- j. M. genavense;
- k. M. xenopi;
- l. M. simiae;
- m. M. fortuitum;
- n. M. celatum;
- o. M. haemophilum;
- p. M. malmoense;
- q. Mycoplasma pneumoniae;

Art Unit:

- r. Mycoplasma genitalium;
- s. Pseudomonas aeruginosa;
- t. Staphylococcus aureus;
- u. Staphylococcus epidermidis;
- v. Acinetobacter baumannii;
- w. Listeria monocytogenes;
- x. Brucella;
- y. Salmonella;
- z. Chlamydia trachomatis;
- aa. Chlamydia psittaci;
- bb. Streptococcus;
- cc. Yersinia enterocolitica

2. The inventions listed as a-cc above do not relate to a single general inventive concept under PCT Rule 13.1 because, under PCT Rule 13.2, they lack the same or corresponding special technical features for the following reasons: the special technical feature for each of the above 29 inventions relates to the unique combination of nucleotide sequence and hybridization specificity which constitutes each of said individual inventions. Based upon search burden considerations, it is deemed that five of the above inventions is reasonable for examination; therefore, applicant must restrict the claims to five of the above species or groups of species and clearly point out which of the large number of SEQ ID Nos pertain to each of the elected groups. Submitting amended claims which are drawn only to the elected inventions/SEQ ID Nos would greatly facilitate prosecution.

Art Unit:

3. A telephone call was made to B. J. Sadoff on 08/18/97 to request an oral election to the above restriction requirement, but did not result in an election being made.

Applicant is advised that the response to this requirement to be complete must include an election of the invention to be examined even though the requirement be traversed (37 CFR 1.143).

4. Applicant is reminded that upon the cancellation of claims to a non-elected invention, the inventorship must be amended in compliance with 37 CFR 1.48(b) if one or more of the currently named inventors is no longer an inventor of at least one claim remaining in the application. Any amendment of inventorship must be accompanied by a diligently-filed petition under 37 CFR 1.48(b) and by the fee required under 37 CFR 1.17(h).

5. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Dr. Kenneth Horlick whose telephone number is (703) 308-3905. The examiner can normally be reached on Monday-Thursday from 6:30 AM-5:00 PM.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, W. Gary Jones, can be reached at (703) 308-1152.

Any inquiry of a general nature or relating to the status of this application should be directed to the Group receptionist whose telephone number is (703) 308-0196.

6. Papers related to this application may be submitted to Group 1800 by facsimile transmission. Papers should be faxed to Group 1800 via the PTO Fax Center located in Crystal Mall 1. The faxing of such papers must conform with the notice published in the Official Gazette, 1096 OG 30 (November 15, 1989). The CM1 Fax Center numbers for Group 1800 are (703) 305-3014 and 305-4227.

KENNETH R. HORLICK
PRIMARY EXAMINER
GROUP 1800

Kenneth R. Horlick, Ph.D.
9/3/97